

Appl. No.: 10/771,746  
Amdt. Dated: 10/13/2005  
Off. Act. Dated: 07/13/2005

### **REMARKS/ARGUMENTS**

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

1. **Rejection of Claims 1-8 and 10-30 under 35 U.S.C. § 102(e).**

Claims 1-8 and 10-30 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hallam-Baker (U.S. Pub. No. 2004/0205135).

After carefully considering the grounds for rejection, the Applicant responds as follows.

(a) **Claims 1 and 16.** Claims 1 and 16 are independent method and system claims, respectively. In support of the rejection, the Examiner states that Hallam-Baker teaches all of the elements of both Claims 1 and 16. However, the Examiner only reads the cited references onto the last two elements of the claims; namely, that of (1) *"determining a trustworthy status of the originating server"* (citing paragraphs [0008]-[0009] of Hallam-Baker), and (2) *"selectively presenting the electronic message to a recipient device based on the trustworthy status of the originating server"* (citing paragraph [0023] of Hallam-Baker).

#### **NOT ALL CLAIM LIMITATIONS ARE TAUGHT BY REFERENCE**

Paragraphs [0008]-[0009] of the cited reference describe attaching a digital signature (credential) to each email such that the veracity of the signature can be ascertained by the receiver. For instance in paragraph [0008] it is stated: *"A sender can associate a credential (e.g., a digital signature, a digital certificate, etc.) with a message. A credential is a statement whose authenticity can be verified, and that is resistant to unauthorized modification, i.e., its integrity has not been compromised."* In paragraph [0023] the decision has already been made by the referee and the email is selectively delivered depending on whether the email is deemed good or bad.

However, from the above portions of Hallam-Baker cited by the Examiner in support of the rejection, it can be clearly seen that these teachings in no way comport to a process of *"detecting an originating server associated with the electronic message"*

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or to a communication *"confirming with the originating server that the originating server sent the electronic message"* as recited in Applicant's Claims 1 and 16. ***Nor, does any other portion of Hallam-Baker teach that element of Claims 1 and 16. Therefore, since the Applicant's claims recite at least one element not taught by Hallam-Baker, Claims 1 and 16 (as well as the claims that depend therefrom) are not anticipated by the cited reference.***

Furthermore, Hallam-Baker does not teach the element of *"determining a trustworthy status of the originating server"* recited in Claims 1 and 16. The *"trustworthiness"* being checked in Hallam-Baker is that of the data included within the certificate, which is checked with a third party certification authority, ***not the trustworthy status of the originating server.*** In this regard, note paragraph [0008] of Hallam-Baker which provides the following example:

*"For example, the statements "The sender of this e-mail is Joseph Smith, 100 ABC Way, Sometown, N.Y. 14593" and "The sender of this e-mail has sent 3,562 e-mails in the past hour." can be hashed (e.g., using the MD5 algorithm), and the resulting hash can be signed by the sender's private key. The sender's corresponding public key can be signed by a Certification Authority (a trusted third party). In this example, a credential can include, among other things, the statements (which may or may not be encrypted); the sender's public key; and the Certification Authority's signature of the sender's public key. A recipient can verify the authenticity and integrity of the credential by verifying the sender's public key by consulting the Certification Authority, and then verifying the statements using the sender's verified public key." (emphasis added)*

As can be seen, the trustworthy status of the originating server is not being determined in Hallam-Baker; instead, the data is being checked through the use of keys and certificates. Although certain embodiments of the Applicant's invention provide for the identification of the originating server being included within an identifier or digital certificate (e.g., as recited in Claims 4-5), the certificate is used for communicating additional information to allow the receiving end (such as the mail server of the recipient) to perform the steps of confirming with the originating server, determining the

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trustworthy status of the originating server, and selectively presenting the electronic message to the recipient, ***and not for determining the trustworthiness of the originating server.***

In view of the above, the Applicant respectfully submits that Hallam-Baker has been misapplied and does not teach what it is purported to teach. It is immaterial if a contention can be made that the embodiment is directed toward a similar idea or inventive concept. See, for example, the following statement by the Administrative Patent Judge in Appeal No. 96-0651 of Application No. 08/087,1641, heard February 11, 1999:

*"Merely because two systems perform the same or a similar function does not, per se, make those systems patentably indistinct. For example, a quill and ink, a ballpoint pen and an electronic word processor may all perform the same function, i.e., the writing of a document, but, clearly, they do not perform the same function in the same manner."*

In the instant application, Claims 1 and 16 recite embodiments of a method and system which contain elements that are not taught by Hallam-Baker. To support an anticipation rejection, every claim element must be taught or inherent in a single prior art reference, Manual of Patent Examining Procedure (MPEP) §706.02a. Nor does Hallam-Baker provide any suggestion, motivation or incentive from which one of ordinary skill in the art would find the combination of elements in Claims 1 and 16 to be obvious in view of Hallam-Baker. There is no basis for arguing prima facie obviousness of those claims in view of Hallam-Baker.

Therefore, the Applicant respectfully submits that Claims 1 and 16 are novel and nonobvious in view of Hallam-Baker. Accordingly, the Applicant respectfully requests that the Examiner allow Claims 1 and 16, as well as the claims that depend therefrom.

(b) Claims 17, 26 and 30. Independent Claims 17, 26 and 30 recite steps, or structures, for carrying out the certification process for the electronic mail message.

In support of the rejection, the Examiner outlines method steps of Claim 17 and,

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as with the rejection of Claims 1 and 16, asserts that the last two of the five claim elements equate to portions of the Hallam-Baker reference.

Again, however, this is not the test of anticipation. In order for a claim to be anticipated by a reference, the reference must teach *all* of the elements of the rejected claim.

Here again, Hallam-Baker does not teach all of the elements of the rejected claims. For example, Hallam-Baker does not teach "*detecting receipt of an electronic message*", "*detecting an originating server associated with the electronic message*" or "*confirming with the originating server that the originating server sent the electronic message*". These elements apparently were overlooked by the Examiner.

#### NOT ALL CLAIM LIMITATIONS ARE TAUGHT BY REFERENCE

For example, Hallam-Baker does not teach "*matching an identity of the originating server with a record that contains information regarding the originating server*" as recited in Claim 17. Specifically, Paragraphs [0008]-[0009] of Hallam-Baker describe attaching a digital signature (credential) to each email such that the veracity of the signature can be ascertained by the receiver. Notably, Hallam-Baker states in paragraph [0008] that "*A sender can associate a credential (e.g., a digital signature, a digital certificate, etc.) with a message. A credential is a statement whose authenticity can be verified, and that is resistant to unauthorized modification, i.e., its integrity has not been compromised.*" This is not the same as "*matching an identity of the originating server with a record that contains information regarding the originating server*" as recited in Claim 17.

Additionally, the Applicant has amended this element of Claim 17 for further clarification by adding the phrase "*which has been confirmed as the sender of the electronic message*", which lends even further distinction from the relied-upon reference.

As can be clearly seen from the above, Hallam-Baker does not does not teach

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all of the elements of Claim 17. As indicated previously, a reference must teach all of the elements of the claim for it to be considered an anticipatory reference. Anticipation requires the presence, in a single prior art disclosure, of all elements of a claimed invention arranged as in the claim. Anticipation is not shown by a prior art disclosure which is only "substantially the same" as the claimed invention. Jamesbury Corp. v. Litton Industrial Products, Inc. 756 F.2d 1556, 225 USPQ 253 (Fed.Cir. 1985).

Claims 26 and 30 have similar limitations as discussed above which are not present within the relied-upon Hallam-Baker reference.

Therefore, Claims 17, 26 and 30 are not anticipated by Hallam-Baker. Nor does Hallam-Baker provide any suggestion, motivation or incentive from which one of ordinary skill in the art would find the combination of elements in Claims 17, 26 and 30 to be obvious in view of Hallam-Baker. There is no basis for arguing prima facie obviousness of those claims in view of Hallam-Baker.

Therefore, the Applicant respectfully submits that Claims 17, 26 and 30 are novel and nonobvious in view of Hallam-Baker. Accordingly, the Applicant respectfully requests that the Examiner allow Claims 17, 26 and 30, as well as the claims that depend therefrom.

2. Rejection of Claim 9 under 35 U.S.C. § 103(a).

Claim 9 was rejected under 35 U.S.C. § 103(a) as being obvious in view of the combined teachings of Hallam-Baker (U.S. Pub. No. 2004/0205135) and Wang et al. (U.S. Pub. No. 2004/0203589).

Claim 9 is a dependent claim which recites "*assigning a digital certificate to the originating device*". In support of the rejection, the Examiner asserts that Wang teaches assigning digital certificates to sending devices (paragraphs [0018] and [0022]). However, referring to a teaching in Hallam-Baker where a digital certificate is assigned to the originating device does not overcome the fundamental problem that Hallam-Baker does not teach, suggest, or provide motivation or incentive for "*detecting an originating server associated with the electronic message*" or "*confirming with the*

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*originating server that the originating server sent the electronic message"* as per Claim 1 which is the base claim.

As required by MPEP 2143.03, all claim limitations must be taught or suggested by the cited combination in order to establish *prima facie* obviousness. See also, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The cited combination clearly does not teach all of the elements recited in Claim 9 (or Claim 1). Nor does the cited combination provide any suggestion, motivation or incentive from which one of ordinary skill would find the totality of elements in Claim 9 to be obvious. Therefore, the Applicant respectfully requests that the Examiner allow Claim 9.

3. Claims 1-8 and 10-30 are nonobvious.

Nor would the subject matter of Claims 1-8 and 10-30 be obvious to a person having ordinary skill in the art in view of Hallam-Baker or Wang, either singly or in combination. Neither reference cited by the Examiner, nor the combination thereof, suggests, teaches or provides motivation for confirming with the originating server that it sent the electronic mail message. Nor is there any suggestion, teaching or motivation which could be derived from either reference which would cause a person having ordinary skill in the art to so modify Hallam-Baker's email scheme. Hallam-Baker neither addresses the problem nor suggests a solution. Similarly, Wang has no structure or mechanism or teachings which provide for the confirmation with the originating server which allows trustworthiness of emails to be discerned. It should also be noted that both of these references are complete in themselves, with no need of incorporating the confirmation aspects.

Therefore, since there is no need for confirming with the originating server as

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identified in either reference and, further, since there is no suggestion, teaching or motivation which can be found in either reference from which a person having ordinary skill in the art would find it obvious to modify either messaging system to correspond to that described in the Applicant's claims, Claims 1-8 and 10-30 recite elements which when viewed as a whole are patentable over the cited references for purposes of 35 U.S.C. § 103.

4. Traversal of Rejection of Claim 16: In re Donaldson.

The Applicant respectfully traverses the grounds for rejection of Claim 16, and cites *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(en banc) as the basis for the traversal. Claim 16 is written in means plus function form pursuant to 35 U.S.C. §112, sixth paragraph, and therefore, must be interpreted during examination under *In re Donaldson*.

In rejecting Claim 16, the Examiner made no specific fact findings as to the scope of equivalents for the means plus function elements in the claims. Instead, the Examiner appears to have followed the provisions of MPEP § 2183 ("Making a Prima Facie Case of Equivalence"), which states:

If the examiner finds that a prior art element performs the function specified in the claim, and is not excluded by any explicit definition provided in the specification for an equivalent, the examiner should infer from that finding that the prior art element is an equivalent, and should then conclude that the claimed limitation is anticipated by the prior art element. The burden then shifts to applicant to show that the element shown in the prior art is not an equivalent of the structure ... disclosed in the application. *In re Mulder*, 716 F.2d 1542, 219 U.S.P.Q. 189 (Fed. Cir. 1983). No further analysis of equivalents is required of the examiner until applicant disagrees with the examiner's conclusion, and provides reasons why the prior art element should not be considered an equivalent.

The Federal Circuit has held that an examiner "construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure ... described therein, and equivalents thereof," *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(en banc), and in so ruling expressly

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denied that "the PTO is exempt from this mandate." *Id.* The Federal Circuit added that it was specifically overruling any precedent that suggested or held to the contrary. *Id.* at 1193-94. In response to the PTO's argument that the court's ruling conflicted with the principle that a claim should be given its broadest reasonable interpretation during prosecution, the Federal Circuit held that the Donaldson decision was setting "a limit on how broadly the PTO may construe means-plus-function language under the rubric of 'reasonable interpretation.'" *Id.* at 1194. In other words, an examiner's claim interpretation is not "reasonable" if it is not based on the specification's description of the implementation of the means element of the claim. The court then said, "Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such [means-plus-function] language when rendering a patentability determination." *Id.* at 1195.

Here, as in *Donaldson*, the Examiner is required by statute to look to the Applicant's specification and construe the "means" language as referring to corresponding means disclosed in the specification and equivalents thereof." See *id.* at 1195. However, the Examiner did not construe the means language of these claims, however. Nor did the Examiner find, on the basis of specific facts of record here, that the means disclosed in the Applicant's specification were equivalent to that of the cited references. Instead, as prescribed by MPEP §§ 2183-84, the Examiner simply presumed equivalence. The presumption methodology used here, which the MPEP prescribes, clearly conflicts with the requirements of the Federal Circuit's *Donaldson* decision. The approach taken by the Examiner in this case also conflicts with *In re Bond*, 931 F.2d 831 (Fed. Cir. 1990).

The very point of these cases is that, in this context, limitations from the specification control the interpretation of the claim. Under §112, paragraph 6, a means-plus-function element of a claim must be construed to mean that which is disclosed in the specification and its equivalents. In *Donaldson*, the Federal Circuit said that "our holding does not conflict with the general claim construction principle that



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limitations found only in the specification of a patent or patent application should not be imported or read into a claim." In other words, the court was saying that a §112, paragraph 6 "means" element does not need to be "imported or read into" a means-plus-function claim because the specification's limitations and their equivalents are already in the claim by virtue of §112, paragraph 6's command. Thus, the Federal Circuit said (16 F.3d at 1195): "What we are dealing with in this case is the construction of a limitation already in the claim in the form of a means-plus-function clause and a statutory mandate on how that clause must be construed."

Based on the foregoing, the Applicant respectfully submits that the rejection of Claim 16 lacks proper foundation and that the rejection should be withdrawn. This claim which includes means plus function limitations, should have been interpreted in view of the specification as required by *In re Donaldson*. If Claim 16 had been so interpreted, Claim 16 would have been allowable since the cited references do not, singly or in combination, teach, suggest or provide motivation or incentive for the subject matter recited in that claim.

5. Amendment of Claims 1, 16, 17, 26 and 30.

Claims 1, 16, 17, 26 and 30. These independent claims were amended to recite the detecting of an electronic message with greater particularity. Specifically, the electronic message is detected during receipt. This makes it clear that the detecting step does not occur at the server which is sending the electronic message as this would not be in keeping with the present invention.

Support is found throughout the specification, including FIG. 7 as well as page 18, line 3 through page 19, line 20, and so forth.

Claim 17. Independent Claim 17 has been further amended to recite the matching process with greater particularity, specifically, "*which has been confirmed as the sender of the electronic message*". This change shows the relation between the matching step and the preceding confirmation step. Support is found in the specification, including page 17, lines 7-16.

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Claim 26. Independent Claim 26 has been further amended to recite the confirmation aspect as already recited within Independent Claims 1, 16, 17 and 30.

The minor nature of these amendments should in no way alter the scope of the claims.

6. Amendments Made Without Prejudice or Estoppel.

Notwithstanding the amendments made and accompanying traversing remarks provided above, Applicant has made these amendments in order expedite allowance of the currently pending subject matter. However, Applicant does not acquiesce in the original ground for rejection with respect to the original form of these claims. These amendments have been made without any prejudice, waiver, or estoppel, and without forfeiture or dedication to the public, with respect to the original subject matter of the claims as originally filed or in their form immediately preceding these amendments. Applicant reserves the right to pursue the original scope of these claims in the future, such as, for example, through continuation practice.

7. Conclusion.

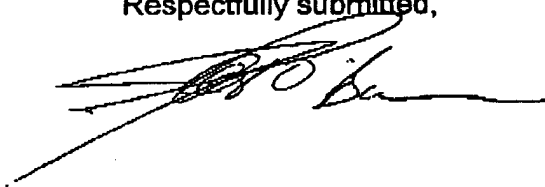
Based on the foregoing, Applicant respectfully requests that the various grounds for rejection in the Office Action be reconsidered and withdrawn with respect to the presently amended form of the claims, and that a Notice of Allowance be issued for the instant application to pass to issuance.

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In the event any further matters remain at issue with respect to the instant application, Applicant respectfully requests that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this application.

Date: 10/13/05

Respectfully submitted,



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